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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,014	10/31/2003	David Christopher Majercak	CRD-5057	1422

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PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

GBERBI, SUZETTE JAIME J

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

8N

Office Action Summary	Application No.	Applicant(s)	
	10/699,014	MAJERCAK ET AL.	
	Examiner	Art Unit	
	Suzette J Gherbi	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 23,26,27,29 and 32-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-22,24,25,28,30 and 31 is/are rejected.
- 7) ☒ Claim(s) 7 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/18/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>mark-up copy of drawings</u> . |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species A, figures 1-2A in the reply filed on 3/11/05 is acknowledged. The traversal is on the ground(s) that the groupings do not establish separate status in the art. This is not found persuasive because the inventions have acquired a separate status in the art as shown by their different classification, (for example the search could be in filters which is 606/200 or over in stent grafts 623/1.13 which are clearly different areas) and the search required for Species A is not required for the other groups, the restriction for examination purposes as indicated is proper. The requirement is still deemed proper and is therefore made FINAL. The claims which will be examined are **1-22, 24-25, 28, and 30-31** which read on elected figures 1-2A.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

Art Unit: 3738

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 5-6, 22, 25, 28, 30-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Boyle et al. 2004/0015184. Boyle et al. discloses the invention as claimed noting figures 1-2, and 4 (see enclosed mark-up copy) comprising: A radially expandable structural frame defining a longitudinal axis, including an anchor structure having first and second open ends, (stent 34) a connecting member (36) having a first end and a second end, the first end of the connecting member being attached to the second end of the anchor structure, and a cantilever valve strut (see marked up copy) having first and second ends, the first end of the cantilever valve strut being cooperatively associated with the second end of the connecting member; and a biocompatible membrane (38) assembly having a substantially tubular configuration (see figure 4) disposed longitudinally about the structural frame, the membrane assembly including a first end having a first diameter and a second end with a second diameter, wherein the first diameter is greater than the second diameter, the first end of the membrane assembly is attached along the second end of the cantilever valve strut.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 3738

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6, 8-22, 25, 28, 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle et al. 2004/0015184 in view of Boylan et al. 2004/0267301 and further in view of Crank et al. 2004/0158275. Boyle et al. has been disclosed above however Boyle et al. does not specifically name the struts. It is obvious to one having ordinary skill in the art that the members attached to the membrane filter are "struts" because noting figures 3 and 4 they are in a first rigid position pressed against the blood vessel 12 and a second compressed position noting in figure 3 and thus meet the definition of a strut which is a bar or a rod. Boyle does not specify the material of the struts or membrane/filter. Boylan et al teaches a device with struts that can be made of a variety of metals or polymers [0018] and filters/membranes made of a variety of materials [0022] including polymers, synthetic material; and Boylan et al also teaches that the struts can be coated with an "agent" [0162] polymer to prevent debris from sticking to the struts. It would have been obvious to one having ordinary skill in the art at the time the invention was made to take the device of Boyle et al. and incorporate the materials used by Boylan et al. because both devices have struts and filters utilized to entrap embolic debris. However Boyle and Boylan et al. do not specify the use of a therapeutic agent or drug. Crank et al. teaches that filters/membranes can incorporate therapeutic coatings either as a coating or doped or imbedded within the filter/membrane material see [0031]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to take the filters as taught by Boyle

and Boylan and utilize a therapeutic material as taught by Crank because they all indicate that polymer materials can be used to make the filter/membranes and polymers are well known for their ability to carry drugs and therapeutic agents.

Allowable Subject Matter

6. Claims 7 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

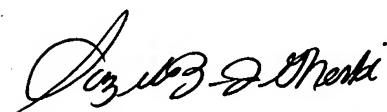
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Van der Burg et al. 2005/0004652 ; McGuckin, Jr. et al. 2005/0004596 ; Jones et al. 2005/0049668 ; Clerc et al. 2004/0133266 ; D'Aquanni et al. 2004/0260331 all show related material.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzette J. Jackson whose work schedule is Monday-Friday 9-6:30 off every other Friday and whose telephone number is 571-272-4751.

Art Unit: 3738

9. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306.

10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

A handwritten signature in black ink, appearing to read 'Suzette J-J Gherbi', written in a cursive style.

Suzette J-J Gherbi
28 March 2005